The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREW J. KUZMA

Appeal No. 2003-0741
Application 08/881,965

ON BRIEF

Before RUGGIERO, LEVY, and MACDONALD, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 22-33, 35-39, and 41-49. Claim 1 has been allowed and claims 2-21, 34, and 40 have been canceled.

The claimed invention relates to a method and apparatus in which feedback information provided from a communications channel

to a video coder/decoder (CODEC) for capturing and encoding real-time information is utilized to drive multiple video output buffers. The multiple output buffers are dynamically created and configured based on one or more characteristics of a communications channel that is used for transmitting the encoded real-time information over a network.

Claim 22 is illustrative of the invention and reads as follows:

22. An apparatus comprising:

an encoder for producing encoded real-time information;

a transmit reference buffer for storing a current transmit reference;

compression circuitry coupled to the encoder and to the transmit reference buffer for producing compressed data based upon the current transmit reference and the encoded real-time information;

a plurality of dynamically created output buffers coupled to the compression circuitry for storing the compressed data, each dynamically created output buffer being created and configured based upon one or more characteristics of a communication channel to be used for transmitting the encoded real-time information over a network; and

a network interface coupled to the plurality of dynamically created output buffers, the network interface for interfacing with the network, for determining a selected output buffer from the plurality of dynamically created output buffers and for transmitting data over the network from the selected output buffer, the selected output buffer containing compressed data which accommodates the one or more characteristics of the network

better than compressed data in at least one other buffer of the plurality of dynamically created output buffers.

The Examiner relies on the following prior art:

Barberis et al. (Barberis)	4,320,500	Mar. 16, 1982
Murakami et al. (Murakami)	5,010,401	Apr. 23, 1991
Parrish et al. (Parrish)	5,117,350	May 26, 1992
Khalil	5,343,465	Aug. 30, 1994 (filed Jun. 11, 1993)
Jeong	5,497,153	Mar. 05, 1996 (filed Jul. 23, 1993)

Claims 22-33, 35-39, and 41-49, all of the appealed claims, stand finally rejected under 35 U.S.C. § 103(a). As evidence of obviousness, the Examiner offers Murakami in view of Barberis and Parrish with respect to claims 22-28, 31, 32, 35, 38, 39, and 41-49, adds Jeong to the basic combination with respect to claims 33 and 36, and separately adds Khalil to the basic combination with respect to claims 29, 30, and 37.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Briefs[1] and Answer for the respective details.

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[1] The Appeal Brief was filed August 30, 2002 (Paper No. 25). In response to the Examiner's Answer dated September 24, 2002 (Paper No. 26), a Reply Brief was filed November 4, 2002 (Paper No. 27), which was acknowledged and entered by the Examiner as indicated in the communication dated November 15, 2002 (Paper No. 28).

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellant's arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as recited in claims 22-33, 35-39, and 41-49. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459,

467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to each of the appealed independent claims 22, 24, 35, 39, 42, 44, and 46, Appellant's response to the obviousness rejection asserts a failure by the Examiner to establish a prima facie case of obviousness since proper motivation for the

Examiner's proposed combination of references has not been set forth. After reviewing the arguments of record from Appellant and the Examiner, we are in general agreement with Appellant's position as stated in the Briefs.

In particular, we agree with Appellant (Brief, pages 11 and 12; Reply Brief, pages 5 and 6) that the Parrish reference, at best, provides a disclosure that dynamically configurable memories are well known, a fact not disputed by Appellant. Our review of Parrish reveals, as also pointed out by Appellant, nothing which would teach or suggest that any dynamic configuration of the described memories is related to or based on the characteristics of a communication channel, a feature present in each of the appealed independent claims.

We also agree with Appellant that the system disclosed by Murakami, which involves plural predefined buffers for alternate transmission and writing, would have no need for any dynamic buffer configuration. Similarly, Barberis provides a predefined number of buffers, each one of which is associated with a node in a communication path. While Barberis discloses the selection of a particular communication path, including its associated node

and buffer, that may provide the shortest distance to a destination node, we see no apparent benefit that would result from a dynamic configuration of such buffers as asserted by the Examiner. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F. 2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992) citing In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

In our view, given the disparity of problems addressed by the applied prior art references, and the differing solutions proposed by them, any attempt to combine them in the manner proposed by the Examiner could only come from Appellant's own disclosure and not from any teaching or suggestion in the references themselves. As asserted by Appellant (Reply Brief, page 9), while it may be obvious to select among a plurality of dynamically configured buffers after they have been configured, we find no motivation established by the Examiner for dynamically configuring the buffers in Murakami as modified by Barberis in the first instance.

We are further of the opinion that even assuming, arguendo, that proper motivation were established for the Examiner's proposed combination of references, we fail to see how and in what manner the references could be combined to arrive at the specific combination set forth in the appealed independent claims. In this regard, we agree with Appellant (Reply Brief, pages 7 and 8) that, at best, the combination of Murakami, Barberis, and Parrish would result in a video signal communications system which utilizes dynamically configured buffers. Such a result, however, would fall well short of the specific combination set forth in each of the appealed independent claims, i.e., an apparatus and method in which the dynamic configuration of buffers is based on the characteristics of a communication channel.

We have also reviewed the Jeong and Khalil references applied by the Examiner to address the audio information and particular communication channel characteristics of several of the dependent claims. We find nothing, however, in either of these references which would overcome the innate deficiencies of the Murakami, Barberis, and Parrish references discussed supra.

In conclusion, since we are of the opinion that the prior art applied by the Examiner does not support the obviousness rejection, we do not sustain the rejection of independent claims 22, 24, 35, 39, 42, 44, and 46, nor of claims 23, 25-33, 36-38, 41, 43, 45, and 47-49 dependent thereon. Therefore, the decision of the Examiner rejecting claims 22-33, 35-39, and 41-49 under 35 U.S.C. § 103(a) is reversed.

REVERSED

JOSEPH F. RUGGIERO)
Administrative Patent Judge)
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STUART S. LEVY)
Administrative Patent Judge) BOARD OF PATENT APPEALS AND INTERFERENCES
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)
ALLEN R. MACDONALD)
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